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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,747	11/28/2001	Hiroyuki Kurase	0879-0364P	8657

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EXAMINER

AGGARWAL, YOGESH K

ART UNIT PAPER NUMBER

2615

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/994,747	KURASE, HIROYUKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yogesh K Aggarwal	2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election without traverse of specie 1, claims 1-6 in the reply filed on 11/22/2004 is acknowledged.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Ejima et al. (US PG-PUB # 2002/0027602).

**[Claim 1]**

Ejima et al. teaches a method of deleting an audio file (represented by the sound icon 63 in figure 10) employing an apparatus (figure 6) having a function of reproducing the audio file to be output as audio (Paragraphs 115-116), comprising reproducing and outputting the audio file selected as a deletion object to allow an operator to confirm whether or not a deletion object is correct, before performing an operation of deleting the audio file from a recording medium in which the audio file is recorded (Paragraphs 131-133, 140-142, figures 10, 11, 13).

**[Claim 2]**

Ejima teach an audio file deletion apparatus (figure 6), comprising a reproduction processing device (CPU 39) which reproduces an audio file from a recording medium (24) in which the

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audio file is recorded (Paragraph 71), an audio output device (5) which outputs the audio reproduced by the reproduction processing device audibly (Paragraph 60), an instruction input device (figure 2, element 7D) which inputs an instruction of deleting the audio file (Paragraphs 37-39), a file deletion device (7) which deletes the audio file from the recording medium (Paragraphs 131-133), and a control device (39), wherein the control device controls to reproduce and output the audio file of deletion object (represented by the sound icon 63 in figure 10) via the reproduction processing device and the audio output device (5) upon an instruction from the instruction input device, accepting an instruction of whether or not the deletion of the audio file is permitted, and enabling the file deletion device to delete the audio file when an instruction of deletion is accepted, or stopping an operation of deleting the audio file when the instruction of deletion is not accepted (Paragraphs 131-133, 140-142, figures 10, 11, 13).

[Claim 3]

Ejima et al. teaches that the claimed invention as shown in the flowchart of figure 15 can also be performed on any general-purpose computer ( Paragraph 157).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. (US PG-PUB # 2002/0027602) in view of Habuto et al. (US Patent # 6,810,441).

[Claim 4]

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Ejima et al. teaches a camera (figure 6) with audio reproduction function (Paragraph 60), comprising an image pick-up device (20) which converts an optical image into an electrical signal (Paragraph 54); an image-capturing instructing device (figure 1, element 10) which instructs the start of taking a picture with the image pick-up device (Paragraph 44), a signal processing device (31) which processes the electrical signal obtained by the image pick-up device to convert it into the image data (Paragraph 55), a recording device (24) which records the image data obtained by the signal processing device on a recording medium (Paragraph 56), a reproduction processing device (39) which reproduces an audio file recorded on the recording medium (Paragraph 60), an audio output device (5) which outputs the audio reproduced by the reproduction processing device audibly (Paragraph 116), an instruction input device (7) which instructs whether the deletion of audio file is permitted or not (Paragraphs 131-133).

Ejima et al. teach a control device (39) which controls to extract the audio file as a deletion object from the recording medium (Paragraph 132) but fails to teach a device which detects an empty capacity of the recording medium; a device which grasps an estimated recording data amount of image acquired by an image-capturing operation using the image pick-up device and deletes the extracted audio file from the recording medium when the empty capacity is less than the estimated recording data amount, performing deletion by the file deletion device under the condition that the deletion of the extracted audio file is permitted, keeping a recording area of the recording medium, and performing an operation of recording the captured image on the recording medium.

However Habuto et al. teaches a MPU 19 (col. 9 lines 64-64, figure 4), which detects an empty capacity of the recording medium and grasps an estimated recording data amount of

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image acquired by an image-capturing operation using the image pick-up device (col. 12 lines 9-29). Habuto et al. further teaches that an extracted audio file is deleted from the recording medium 30 when the empty capacity is less than the estimated recording data amount, performing deletion by a file deletion device 19 under the condition that the deletion of the extracted audio file is permitted, keeping a recording area of the recording medium, and performing an operation of recording the captured image on the recording medium (col. 12 line 30-col. 13 line 19, figure 8) in order to increase the recording capacity by erasing unnecessary data belonging to audio or voice category. Habuto also teaches that not only all audio (non-conforming) files can be deleted but also any one of the audio or voice file can be deleted by displaying the size of the file to be erased (col. 9 lines 11-21).

Therefore taking the combined teachings of Ejima and Habuto, it would have been obvious to one skilled in the art at the time of the invention to have been motivated to have a device which detects an empty capacity of the recording medium; a device which grasps an estimated recording data amount of image acquired by an image-capturing operation using the image pick-up device and deletes the extracted audio file from the recording medium when the empty capacity is less than the estimated recording data amount, performing deletion by the file deletion device under the condition that the deletion of the extracted audio file is permitted, keeping a recording area of the recording medium, and performing an operation of recording the captured image on the recording medium in order to increase the recording capacity for taking the image by erasing unnecessary data belonging to audio or voice category as taught in Habuto (col. 13 lines 17-19).

[Claim 5]

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Habuto et al. teach wherein the control device (19) controls to enable the image-capturing operation even when the empty capacity is less than the estimated recording data amount, allowing the operator to choose a deletable audio file and delete the audio file, and performing a recording operation of image data (col. 12 line 30-col. 13 line 19, figure 8).

[Claim 6]

Ejima et al. teaches wherein the control device controls to reproduce and output the audio file extracted as the deletion object via the reproduction processing device and the audio output device, and then accept an instruction of whether or not the deletion of audio file is permitted (Paragraphs 131-133, 140-142, figures 10, 11, 13).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh K Aggarwal whose telephone number is (703) 305-0346. The examiner can normally be reached on M-F 9:00AM-5:30PM.

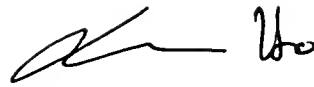
6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Thai Tran can be reached on (703) 305-4725. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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YKA  
February 14, 2005

A handwritten signature in black ink, appearing to be "K. Ho".

PRINCE EXHIBIT